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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,993	04/12/2001	Rana Dutta	770P009597-US(PAR)	1870
2512	7590	04/15/2004	EXAMINER	
<b>PERMAN &amp; GREEN</b> 425 POST ROAD FAIRFIELD, CT 06824				GORT, ELAINE L
		ART UNIT		PAPER NUMBER
		3627		

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/833,993	DUTTA ET AL.
	Examiner	Art Unit
	Elaine Gort	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 February 2004.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 15-22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 15-22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 12 April 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5, 7, 13.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group II, claims 15-22, in Paper No. 12 is acknowledged. All non-elected claims have been cancelled by the Applicant.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 15-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 and 17-22 claim a system for providing an electronic commerce service, but claim only the structure of a system. Although the claimed structure of the system is capable of performing "electronic commerce service" it does not claim any service being performed as the preamble indicates.

Claim 16 is confusing as it is unclear if the "means for causing" is referring to software, another server than the one claimed in claim 15, or if the server claimed in claim 15 is what performs the transfer.

Claim 15 recites the limitation "the respective accounts" in line 10. There is insufficient antecedent basis for this limitation in the claim. For purposes of this action,

it is assumed this limitation is referring to the customer account and/or the merchant account.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang et al. (US Patent 5,884,288).

Chang et al. discloses a system for providing an electronic commerce service, comprising:

A server having a customer account for each customer subscribing to the service (such as payors' account as called "client accounts" disclosed in column 2, line 41 which are stored on the participating Banks' computer systems);

A merchant account for each merchant participating in the service (such as payee's bank account, see column 4, line 66);

Storage apparatus for storing account information of the customer account and account information of the merchant account, the storage apparatus also being for storing sensitive financial information required for funding the respective accounts (such as but not limited to the Banks' databases including the payor and payee account

information which includes for example the bank accounts, the bill payment databases and envelope repository databases, see figure 2);

A first communication connection for the merchant to provide to the server information concerning a purchase (payee sends a bill, see column 4, line 37+, see also payee shown as reference number 208 in figure 2);

A second communication connection for the customer to provide to the server an affirmation of the purchase (payor formulates payment instructions column 4, lines 46+);

Means for causing the server to transfer a value between the customer account and the merchant account, where the value is a function of a purchase amount for an item purchased (such as the crediting of payee's account shown in column 4, line 66); and

Where the information provided by the merchant using the first communication connection includes a purchase amount, a first identification for identifying the customer account and a second identification for identifying the merchant account (such as includes the bill amount, payor to be billed, payee's identification so they know who to pay, see figure 8B.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (US Patent 5,884,288) in view of Microsoft Computer Dictionary.

Chang et al. discloses the claimed device but is silent regarding the use of digital signatures and digital certificates. Microsoft Computer Dictionary discloses, on pages 138 and 139, that it is known in the art to provide a digital certificate and a digital signature to ensure the legitimate online transfer of confidential information by means of public encryption technology and that digital signatures are used to encrypt messages before transmission and to decrypt them on receipt. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the communication between payors/payees and the banks' computer systems of Chang et al. with the digital certificate and digital signatures of Microsoft Computer Dictionary, in order to ensure legitimate transfer of confidential information thru encryption technology.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703)308-5183. The fax phone number for the organization where this application or processing is assigned is (703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Elaine Gort  
Examiner  
Art Unit 3627

April 9, 2004